

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY K. MICHELSON

Appeal No. 97-1782
Application 08/112,426¹

ON BRIEF

Before CALVERT, MEISTER and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 8 and 13 to 15, all the claims remaining in the application.²

¹ Application for patent filed August 26, 1993. According to appellant, this application is a continuation of Application 07/692,583, filed May 13, 1991, now abandoned; which is a continuation of Application 07/341,848, filed April 24, 1989, now abandoned.

² The examiner states in the answer that claims 14 and 15 were inadvertently omitted from the final rejection. It does not appear that appellant has been prejudiced by this omission.

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The appealed claims are drawn to a medical or surgical instrument and to a method for grasping an instrument, and are reproduced in Appendix A of appellant's brief.

The references applied in the final rejection are:³

Polder	4,669,769	June 2, 1997
Wright	4,777,948	Oct. 18, 1988

Industrial Design, Page 56 (Sept. 1968)

The claims on appeal stand rejected under 35 U.S.C. § 103 as follows:

1. Claims 1, 3 to 7, 14 and 15, unpatentable over Polder, optionally in view of Wright;
2. Claims 2, 8 and 13, unpatentable over Polder in view of Industrial Design, optionally in view of Wright.

According to the examiner (answer, page 3), the rationales behind these rejections are correctly described by appellant on pages 5 to 6 of the brief.

After fully considering the record in light of the arguments presented in the appellant's brief and reply brief, and in the examiner's answer and supplemental answer, we conclude that the above-noted rejections will not be sustained. We reach this conclusion even assuming, contrary to the argument in the reply brief, that Polder constitutes analogous art.

³ In the supplemental answer (paragraph 3), the examiner refers to a number of other references of record. These references will be given no consideration since they were not positively included in the statement of the rejection. Ex parte Raske, 28 USPQ2d 1304, 1305 (BPAI 1993).

A principal argument made by appellant is that Polder's handle is convex curved rearwardly, rather than concave. The examiner disagrees, stating that "as best seen in Figures 1 and 3, [Polder] clearly discloses the rear surface of the rear handle is concaved rearwardly" (answer, page 4). However, while Polder unquestionably shows a concavity in the rear surface of grip 12 (e.g., as shown in Fig. 3), we do not consider that the concave curve recited in the claims is readable thereon. Looking at claim 1, for example, in relation to the Polder device, there is recited "a body portion axially aligned with the longitudinal axis of said working shaft." Since Polder's "working shaft" is member 14, the portion of Polder's grip 12 which corresponds to the claimed "body portion" would be the part of the grip which is axially aligned with the longitudinal axis of member 14, and, since the concavity at the rear surface of Polder's grip is in line with or slightly above the longitudinal axis of member 14, the concavity is located in the "body portion" of the Polder device. Claim 1 further recites "a thenar fitting concave rear handle depending downwardly from the rear of said body portion." Polder does not disclose this limitation because, as discussed above, Polder's concavity is in the rear of the "body portion," rather than below it. The rear of the handle which depends downwardly from Polder's "body portion" is convex, not concave, and therefore does not satisfy the "concave rear handle" limitation of claim 1. The Wright reference does not render the recited structure obvious, for

even if the Polder concave curve were made more pronounced, as proposed by the examiner, it still would be located at the rear surface of the "body portion" (as defined in the claim) rather than at the rear surface of the rear handle depending therefrom.

Independent claims 6, 7 and 8 contain similar limitations and are likewise considered patentable over Polder in view of Wright. As for independent claim 13, we find nothing in the Industrial Design publication which would teach or suggest making the rear surface of Polder's depending rear handle concave rather than convex. Accordingly, we will not sustain the rejections of independent claims 1, 6 to 8 and 13, nor, it follows, of dependent claims 2 to 5, 14 and 15.

Conclusion

The examiner's decision to reject claims 1 to 8 and 13 to 15 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JAMES M. MEISTER)	
Administrative Patent Judge)	APPEALS AND
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JEFFREY V. NASE)	
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